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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,741	07/17/2003	Shailendra K. Saxena	5016 US	9430

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EXAMINER

PATTERSON, CHARLES L JR

ART UNIT PAPER NUMBER

1652

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,741

Applicant(s)

SAXENA, SHAILENDRA K.

Examiner

Charles L. Patterson, Jr.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 4-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1652

Applicant's election without traverse of Group I, claims 1-3 in the reply filed on 12/21/05 is acknowledged.

Claims 4-56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/21/05.

Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-3 are indefinite and confusing in the recitation of "claim 0". There is no such claim. Apparently "claim 1" was intended as originally appeared in these claims and this is presumed in the following action.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ardelt, et al. (A) in view of Lehninger. (U) and further in view of Studier, et al. (V), Huang, et al. (W) and Gerrero, et al. (X).

Ardelt, et al. disclose SEQ ID NO:1, the amino acid sequence that is the ribonuclease of the instant claims. Lehninger teaches the "codon dictionary", showing the codons for each amino acid. Studier, et al. teach in the introduction that "T7 RNA polymerase is able to make complete transcripts

Art Unit: 1652

of almost any DNA that is placed under control of a T7 promoter" and on page 65 that "[t]he plasmid vectors we have developed for cloning and expressing target DNAs under control of a T7 promoter are designated pET vectors (plasmid for expression of T7 RNA polymerase)". They further list pET-11d as a translation vector in Table II. Huang, et al and Gerrero, et al. teach the use of pET22b to express a ribonuclease and a peroxidase, respectively.

It would have been obvious to one of ordinary skill in the art to obtain a DNA sequence for the protein taught by Ardelt, et al. by using the codons taught by Lehninger. It would also have been obvious to place the DNA into a vector that uses a T7 promoter and specifically a pET11d vector according to the teachings of Studier, et al. It would have been further obvious to use the teachings of Huang, et al. and Gerrero, et al. to place the DNA into a pET22b with the expectation that the DNA would be translated and expressed.

It is pointed out that the instant claims are drawn to a "DNA that encodes...SEQ ID NO:1", not to any particular DNA such as SEQ ID NO:2. This includes a vast array of DNA sequences. Any DNA that encodes SEQ ID NO:1 would meet the requirements of the instant claims and this could be obtained by using the amino acid sequence taught by Ardelt, et al. in combination with the codons taught by Lehninger. *In re Deuel*, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995) states that "[a] prior art disclosure of the amino acid sequence of a protein does not necessarily render particular DNA molecules encoding the protein obvious because the redundancy of the genetic code permits one to hypothesize an enormous number of DNA sequences coding for the protein". Therefore this ruling does not apply here because a particular DNA molecule is not claimed but rather a "DNA that encodes...SEQ ID NO:1".

Art Unit: 1652

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 571-272-0936. The examiner can normally be reached on Monday - Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
February 21, 2006